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10/665,480

09/22/2003

Reinhold Schmieding

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EXAMINER

PRONE, CHRISTOPHER D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/665,480
Filing Date: September 22, 2003
Appellant(s): SCHMIEDING, REINHOLD

Stephen A. Soffen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/22/08 appealing from the Office action mailed 10/24/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-------------|--------|--------|
| WO 99/21515 | Grooms | 5-1999 |
| 6,045,554 | Grooms | 4-2000 |
| 5,176,682 | Chow | 1-1993 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 10 requires that the cylindrical shaft is “rigid” in lines 11 and 12, but nowhere in the specification is this supported. The specification and figures only disclose that the shaft is smooth and cylindrical.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10, 11, and 13-15 are rejected under 35 U.S.C. 103 as being unpatentable over International Application Publication WO 99/21515 Grooms in view of United States Patent 5,176,682 Chow.

Grooms discloses the invention substantially as claimed being an implant shown in figure 2B comprising a blunt proximal end (202), a tapered distal end adapted to receive a suture (201), a transverse eye (210), and a cylindrical shaft (204). However Grooms fails to teach the use of channels formed on opposite sides of the implant while maintaining the shafts cylindrical outer shape.

Chow teaches the use of a bone anchor comprising a suture passage 18 having channels 20a and 20b formed around the hole, extending to the tip, in order to guide the ligament around the body of the anchor shown best in figures 3-8.

It would have been obvious to one having ordinary skill in the art at the time the invention was made use the tapered channels surrounding the through hole taught by Chow on the implant of Grooms in order to provide an implant that has a smoother guide surface for the suture thread around the through hole thereby relieving stress on the suture.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grooms in view of Chow as applied to claims 10, 11, and 13-15 above, and further in view of United States Patent 6,045,554 Grooms et al.

The combination of Grooms and Chow discloses the invention substantially as claimed being described above. However, the combination does not disclose that the implant is made of allograft or a synthetic bone material.

Grooms 554' teaches the use of an implant made of allograft or synthetic bone material (2:9-22) in the same field of endeavor for the purpose of providing an implant that is capable of fusing with the bone it is implanted into.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the allograft or synthetic bone materials taught by Grooms 554' with the implant of Grooms as modified by Chow in order to provide an implant that has strength comparable to a metallic version, and has the advantage of leaving no residual hardware while contributing to bone stock.

(10) Response to Argument

In regards to the applicant's comments regarding the 112 rejection. The after final amendment did not place the application in condition for allowance, so it was not entered.

The applicant argues that the Grooms does not disclose channels in combination with a traverse eye and that Chow does not teach channels extending the channels to the tip, a traverse eye, or a tapered distal end. The examiner disagrees because the

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combination comprises the device of Grooms, which clearly discloses traverse eye 210, modified to have channels 20 a and b like that of Chow, which clearly extend to the tip. (See figures 5 and 6 of Chow) The applicant's argument over any other lacking deficiencies in Chow are irrelevant because Chow is only used to teach the use of the channels. Applicant argues that claim 11 is not met by Grooms, but Grooms clearly discloses making the implant out of bone in the abstract. Applicant argues that Grooms fails to meet the use requirements of claims 13 and 14, but this is considered intended use and the combination disclosed above is fully capable of performing this task. Applicant argues that claim 15 is not met by Grooms, but Grooms clearly discloses a blunt end 202.

Applicant then provides extensive arguments that it would not have been obvious to combine the cited references, but the combination simply relies on Chow to modify Grooms to have tapered channels that would provide a smoother guide surface for the suture thread around the through hole thereby relieving stress on the suture. The applicant's claims at other structural differences are irrelevant. The applicant continues this approach by pointing out distinct structures of Grooms '554 that would not allow the combination to be made. This is not convincing because Grooms '554 is only relied on for teaching the use of a material.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Christopher D Prone/

Examiner, Art Unit 3738

Conferees:

/Thomas Barrett/

TQAS TC3700

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738